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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,111	09/15/2000	Charles J. Davidson	S63.2H-12013-US01	3759
23552 7590 04/22/2008 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER PREBILIC, PAUL B				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
04/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/663,111

Applicant(s)

DAVIDSON ET AL.

Examiner

Paul B. Prebille

Art Unit

3774

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5-8, 10-19, 42-48, 50-70 and 72-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-8, 10-19, 42-48, 50-70 and 72-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 11/7/07
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notices of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

Specification

The disclosure is objected to because of the following informalities: the continuing data on page 1 of the specification does not list the current status of each application. Appropriate correction is required.

Claim Objections

Claim 50 is objected to because of the following informalities: on line 5 of claim 50, "the branch vessel" lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-8, 10, 12, 13,15-19, 42-48, 50-53, 55, 56, 59-70, and 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US 6,165,195) in view of Ryan et al (US 6,576,009) or Shakovich (US 5,669,924) or

Goicoechea et al (US 5,609,627). Wilson meets the claim language where **(a)** the catheter as claimed is catheter (50) of Wilson (see Figure 12L and column 16, line 35 et seq.), **(b)** the side member as claimed is lumen (55A), **(c)** the free end as claimed is the angled portion (55B), **(d)** the indicator as claimed is marker(s) (see column 17, line 64 to column 18, line 14), and **(e)** the side hole as claimed is aperture (25). Wilson places radiopaque markers on various elements but not multiple markers on each element as claimed. However, Ryan (see Figure 7 to 8B and column 11, line 34 et seq.) or Shakhovich (see column 12, lines 42-47) or Goicoechea (see Figure 4a and column 10, lines 53-64) teaches that it was known to put multiple markers on the same element in order to determine orientation thereof. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to an ordinary artisan to put more than one marker on each element of Wilson for the same reasons that the secondary references did the same.

With regard to claim 8, the Applicant is directed to Figures 14 to 19F and the corresponding descriptions thereof.

Claims 11, 54, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson, Ryan, Shakhovich, and Goicoechea as applied to claim 1 above, and further in view of Dibie (WO 96/34580). Wilson fails to disclose a balloon on the end of the lumen (55B) as required by the claim language. However, Dibie (see the front page thereof) teaches that it was known to put balloons on the ends of similar side members in order to expand side stents. Therefore, it is the Examiner's position that it

would have been obvious to do the same to the Wilson device in order to apply a side stent in one step or for the reasons that Dibie does the same.

Claims 14 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson, Ryan, Shaknovich, and Goicoechea as applied to claim 1 above, and further in view of Davila et al (US 5,851,464). Wilson fails to disclose the use of pebax and graphite in the catheters. However, Davila teaches that it was known to make catheters out of pebax and graphite; see column 3, lines 8-32. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to make the catheter of Wilson out of pebax and graphite for the same reasons that Davila did the same or in order to promote sliding between the catheter and guidewire.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilio whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/
Paul Prebilic
Primary Examiner
Art Unit 3774